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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO.             | CONFIRMATION NO. |
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| 09/730,232   | 12/05/2000  | Alexander I. Poltorak | MI/AP00                         | 7918             |
| 35070 7590 04/07/2006<br>ANATOLY S. WEISER<br>12526 HIGH BLUFF DRIVE<br>SUITE 300<br>SAN DIEGO, CA 92130 |             |                       | EXAMINER<br>MOONEYHAM, JANICE A |                  |
|  |             |                       | ART UNIT<br>3629                | PAPER NUMBER     |

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |   |  |
|------------------------------|--|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/730,232   | <b>Applicant(s)</b><br>POLTORAK, ALEXANDER I. |  |
|                              | <b>Examiner</b><br>Janice A. Mooneyham | <b>Art Unit</b><br>3629                       |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 23 January 2006.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-53,66-72 and 86-88 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-53,66-72 and 86-88 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

|  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |
|--|--|

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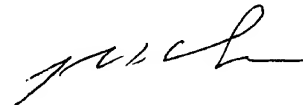
In view of the Appeal Brief filed on January 23, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

### DETAILED ACTION

1. This is in response to the appeal brief filed on January 23, 2006. Claims 1-53, 66-72, and 86-88 are currently pending in this application.

#### ***Claim Rejections - 35 USC § 101***

2. The rejection under 35 U.S.C. 101 has been withdrawn.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, 20, 39, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Lundberg (US 2002/0091541) (hereinafter referred to as Lundberg).

Referring to Claims 1, 39, and 48:

Lundberg discloses a method and system for performing the method of searching intellectual property listings, comprising:

- a) maintaining a user-interface site accessible by a plurality of users (Fig. 1);
- b) establishing a connection to a plurality of third-party sources of intellectual property listings available for transaction ( [0007] *listings available for transacting are records identified according to the criteria and presented to the user for approval to add to the portfolio*)(Fig. 1 (16) *source database of IP asset records*);

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c) receiving from at least one of said plurality of users search criteria for searching said plurality of third-party sources of intellectual property listings (Fig. 2 (22) *enter search criteria*);

d) searching said plurality of third-party sources of intellectual property listings according to said search criteria (Fig. 2 (24) *search source database*);

e) presenting a resulting set of intellectual property listings to said at least one of said plurality of users (Fig. 2 (26) *display retrieved hits*); and

f) receiving from said at least one of said plurality of users an identification of those of said resulting set of intellectual property listings that are of interest to said at least one of said plurality of users (Fig. 2, (28-30) *reject unwanted hits; add wanted records to portfolio database*; pages 1-2 [0009]).

Referring to Claim 4:

Lundburg discloses a method further comprising the step of; establishing contact between said at least one of said plurality of users and those of said plurality of third-party sources including those of said resulting set of intellectual property listings which are of interest to said at least one of said plurality of users (Figs. 1-2; *wide access network (16), such as the Internet*).

Referring to Claim 20:

Lundburg discloses a method wherein said user-interface site is a website (Figs. 1-2, [0007] *the system including HTML (web contains HTML files) or JAVA based browsers interacting through a server computer system through a wide access network such as the Internet*).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 21 and 45-46 and 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tran (US 2002/0095368) (hereinafter referred to as Tran) in view of the article by Peter Fischer, *Opening the Vault; Information exchange*; Technology Information Software Magazine published April 1, 2000 (hereinafter referred to as Fischer).

Referring to Claims 21, 45, and 49-53:

Tran discloses a method and system for performing the method of searching intellectual property listings online, comprising the steps of:

a) maintaining a user-interface site accessible by a plurality of users ([0007-0008] *a system supports trading of intellectual property (IP) with a user interface; Fig. 1 workstations 104-106*);

b) maintaining access to a predetermined set of third-party sources of intellectual property listings searchable online ([0009] *online trading is done through a network-based community in which buyers and sellers are brought together*; Figure 1; page 1 [0006] thru page 2 [0012]; page 2 [0014] *one or more client workstations 104-106 are connected to the network 102. Additionally, an Internet community 110 with one or more service providers, manufacturers, or marketers are connected; see also*

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*[0009] the portal provides the user with access to a network of IP lawyers and links the user to IP related business such as those who specialize in trading or mediating IP related issues);*

c) eliciting from each user search criteria for searching each of said third-party sources of intellectual property listings (page 1 [0006] thru page 2 [0012], page 3 [0017] a user can simply search for desired assets; [0022] by having access to the member's IP interests, the portal can provide pre-screened, high-quality investment opportunities that match the investor's identified interest [0035] profile is used to create personalized pages for members by dynamically serving-up the content to each user utilizing dynamic HTML, among others [0007] to narrow the list, the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have);

d) designating first and second memory storage areas for storage of intellectual property listings (page 1 [0006] thru page 2 [0012], page 4 [0023] by offloading the storage on the server, the user minimizes the memory required on the client workstation – thus server memory and workstation memory);

Tran does not specifically disclose reformatting the data or taking a snapshot of the data.

However, Fischer discloses formatting and reformatting data (page 3 Information Portals) and snapshots (page 6 last paragraph – Information snapshots)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the intellectual property management invention disclosed in Lundberg the information portals with XML repositories taught in

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Fisher so as to provide access to a wide array of corporate information in disparate databases and processing systems, wherein the data is gathered by the freezing of data at a predetermined point in time, thus giving a more accurate data set.

Referring to Claims 46:

Lundberg discloses a server computer ([0007] (12))

5. Claims 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tran and Fisher as applied to claim 21 above, and further in view of Kimball, Ralph, Fundament Grains; Technology Information Intelligent Enterprise published on March 30, 1999.

Referring to Claim 22:

Tran and Fisher disclose a method for searching intellectual property listings and via a portal with the ability to take snapshots. Tran nor Fisher explicitly disclose taking a new (updates) snapshot or comparing snapshots or updating snapshots.

However, Kimball discloses periodic snapshots and accumulating snapshots wherein the accumulating snapshot often combines the most recent volatile status with measures that accumulate from the beginning history (page 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the portal exchange and intellectual property trading invention disclosed in Tran and Fisher with the periodic snapshots disclosed in Kimball so as to get a complete picture of a business's database information.



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Referring to Claim 23:

Tran discloses further comprising the steps of;

p) presenting a resulting set of intellectual property listings to said user (page 1 [0006] thru page 2 [[0012], [0045] *to narrow the list, the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have*); and

q) eliciting from said user an identification of those intellectual property listings which are of interest (page 1 [0006] thru page 2 [0012], [0045] *to narrow the list, the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have*).

Referring to Claim 24:

Tran discloses a method further comprising the step of:

r) securing permission from each of said third-party sources of intellectual property listing allowing search of said third-party sources and presenting listings therefrom to said user (page 3 [0022] *the portal permits sellers to list assets for sale (ie, sellers choose to list assets or grant permission; portal provides access to members;* page 4 [0024] *agreement*).

Referring to Claim 25:

Tran discloses a method further comprising the step of:

s) securing from each of said third-party sources of intellectual property listings a fee-sharing agreement in respect of any fees paid as a result of transactions arising out of contacts initially made through said user-interface site ([0017] *no fees are charged to the buyer for this service; [0020] the system assumes that the seller pays the transfer*

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*fee unless otherwise instructed; [0023] transaction usage fee, [0027] pre-determined annual membership fee and transaction fee; [0031] parties can negotiate fees relating to subsequent questions and/or work[0008] specialists can be paid on a commission basis).*

Referring to Claim 26:

Tran discloses a method further comprising the step of:

r) establishing contact between said user and the third party maintaining said intellectual property listings which are of interest (page 1 [0006] thru page 2 [0012] [0011] *portal provides the user with access to a network of IP lawyers for assistance and links the user with IP related businesses*).

Referring to Claim 27:

Tran does not disclose wherein the step of establishing contact includes the step of hyper-linking the user to the third party and transmitting to the third party a unique identifier identifying the user interface site.

However, the Examiner takes Official Notice that it is old and well known to provide hyperlinks to information as is evidenced by the PTO web page wherein hyperlinks are provided to link the user with the information the user is seeking. The Examiner also takes Official Notice that it is old and well known to transfer information via e-mails with hyperlinks (See Snyder US Patent 6,643,641).

However, this would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate hyperlinks into the intellectual property exchange disclosed in Tran since it is well known in the computer industry to use hyperlinks and

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unique identifiers so as to provide quick and convenient access to resources and to provide some indication of which interface the third party needs to respond to.

Referring to Claim 28:

Tran discloses a method further comprising the step of:

r) providing said user with a transaction manager ([0025] *Intellectual property assistant (assistant)*) to facilitate a contemplated intellectual property transaction (page 1 [0006] thru page 2 [0012]; [0014], [0016], [0025]).

Referring to Claim 29:

Tran discloses a method further comprising the step of:

s) said transaction manager contacting said third party maintaining the listings of the intellectual property being of interest to said user to facilitate said transaction (page 1 [0006] thru page 2 [0012], [0014], [0016] and [0028] *the search engine will use user profile to search web, store the results and relay information to user. The portal delivers focused IP contents to interested subscribers*).

Referring to Claims 30-32:

Tran discloses a method further comprising the steps of:

r) designating a memory for temporary storage of intellectual property listings matching said search criteria elicited from said user (page 1 [0006] thru page 2 [0012]) [0023] *a user can rent space on the server to enable him/her to download application software (applets) and /or data anytime and anywhere. By off loading the storage on the server, the user minimizes the memory required on the client workstation - server*

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*memory and workstation memory (page 1 [0006] thru page 2 [0012]) [see [0017] user can search for desired IP assets [0023] and [0025], and*

t) collecting such intellectual property listings that match said criteria and storing said listings in said buffer memory (Figs 1, page 1 [0006] thru page 2 [0012] and [0023] *server memory enables complex operations to run and yet still ensures that user can access the application and related information anywhere anytime).*

Tran does not disclose searching reformatted snapshots.

However, Fischer discloses a portal server that captures information snapshots in aggregate XML objects and wherein the portal server includes information connectors that allow users to access, retrieve, transform and update information stores in a variety of legacy systems and data sources (page 6 last two paragraphs).

The Examiner takes Official Notice that it is old and well known to search returned search data as is evidenced by an advance Google search or a search using the East database wherein searches are returned, information is displayed and searches can be performed on individual items of interest (see also Snyder US 6,643,641).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the portal exchange and intellectual property invention disclosed in Tran and Fischer the ability to search reformatted snapshots so that the user can refine a search result to find the exact data needed.

Referring to Claims 33-38:

Tran discloses a method further comprising the step of making available to said user analytical tools for valuation and analysis of the intellectual property ([0019] *electronic valuation module to estimate the value of the IP asset*), wherein said analytical tools are not available from the third party maintaining said intellectual property listings which are of interest, further comprising making available to said user escrow services related to a contemplated intellectual property transaction )([0020] *Escrow button allows a buyer and seller to have a neutral third party watch over the title transfer process*), wherein said services are not available from the third party maintaining said listings of said intellectual property which are of interest, comprising the step of making available to said user title insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction ([0022] *the portal offers forums providing articles, insights and information about insurance*), wherein said title insurance is not available from the third party maintaining intellectual property listings which are of interest, further comprising the step of making available to said user patent validity insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction, wherein said patent validity insurance is not available from the third party maintaining said intellectual property listings which are of interest ([0022] *insurance*) further comprising the step of making available to said user consulting services related to a contemplated intellectual property transaction, further comprising the step of making available to said user legal services related to a contemplated intellectual property transaction [0030-0031] *the portal allows user to draft*

*applications; a network of independent patent attorneys can perform checks*) (pages 2-3 [0016], [0019], pages 3-4 [0022]).

6. Claims 2-3, 5-7, 11-16, 19, 40-44, 47, 66-72, and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg as applied to claims 1 and 39 and further in view of Tran.

Referring to Claim 2:

Lundberg does not disclose securing permissions.

However, Tran discloses a method further comprising the step of:

r) securing permission from each of said third-party sources of intellectual property listing allowing search of said third-party sources and presenting listings therefrom to said user (page 3 [0022] *the portal permits sellers to list assets for sale; portal provides access to members; page 4 [0024] agreement*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tran with the method of Lundberg so as to facilitate the licensing and trading of IP assets between buyers who are looking to buy and sellers who actually want to sell.

Referring to Claim 3:

Tran discloses a method further comprising the step of:

s) securing from each of said third-party sources of intellectual property listings a fee-sharing agreement in respect of any fees paid as a result of transactions arising out of contacts initially made through said user-interface site ([0017] *no fees are charged to*

*the buyer for this service; [0020] the system assumes that the seller pays the transfer fee unless otherwise instructed; [0023] transaction usage fee, [0027] pre-determined annual membership fee and transaction fee; [0031] parties can negotiate fees relating to subsequent questions and/or work; [0008] IP specialists can be paid on a commission basis).*

Referring to Claims 11-16, 40-42, 86-88:

Lundburg discloses the invention as set forth in Claims 1 and 39.

Lundburg does not disclose the goods comprising business available for sale or merger, goods comprising venture capital, a transaction manager to facilitate a contemplated transaction or an Internet auction site.

However, Tran discloses wherein said goods comprise businesses available for sale, merger or acquisition, wherein said goods comprise venture capital available for investment [0009] and [0022] *portal provides access to non-IP resources including venture capitalists and analyst), further comprising providing a transaction manager ([0025] intellectual property assistant) to facilitate a contemplated transaction between said user and the provider of said goods or services, wherein said third-party listings are comprised by Internet auction sites ([0006] system supports purchasing or selling with a computerized bid, auction and sale system over a network such as the Internet; page 2 [0016] thru page 4 [0022]).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the trading method of Tran with intellectual property management method of Lundberg so as to enhance the licensing and trading of IP assets and to offer

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a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and to target technology without taking a long time to find a buyer for each available technology.

Referring to Claims 5:

Neither Lundberg nor Tran disclose wherein the step of establishing contact includes the step of hyper-linking the user to the third party and transmitting to the third party a unique identifier identifying the user interface site.

However, the Examiner takes Official Notice that it is old and well known to provide hyperlinks to information as is evidenced by the PTO web page wherein hyperlinks are provided to link the user with the information the user is seeking. The Examiner also takes Official Notice that it is old and well known to transfer information via e-mails with hyperlinks (See Snyder US Patent 6,643,641).

However, this would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate hyperlinks into the intellectual property exchange disclosed in Tran since it is well known in the computer industry to use hyperlinks and unique identifiers so as to provide quick and convenient access to resources and to provide some indication of which interface the third party needs to respond to.

Regarding Claim 6:

Tran discloses a method further comprising the step of:

r) providing said user with a transaction manager ([0025] *Intellectual property assistant (assistant)*) to facilitate a contemplated intellectual property transaction (page 1 [0006] thru page 2 [0012]; [0014], [0016], [0025]).



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Referring to Claim 7:

Tran discloses a method further comprising the step of:

s) said transaction manager contacting said third party maintaining the listings of the intellectual property being of interest to said user to facilitate said transaction (page 1 [0006] thru page 2 [0012], [0014], [0016] and [0028] *the search engine will use user profile to search web, store the results and relay information to user. The portal delivers focused IP contents to interested subscribers*).

Referring to Claims 19 and 43:

Tran discloses the third party sources as Internet auction sites ([0006] *auction and sale system over a network such as the Internet*).

Referring to Claims 44 and 47:

Tran discloses wherein the user interface is a website ([0016] *user interface is a web-based user interface*) and third party user interface sites comprise Internet auction sites {0006} *auction and sale system over the Internet*)

Referring to Claims 66-72:

Tran discloses method and system for searching intellectual property listings online, comprising:

a) making available to a user a software application for installment on said user's computing device, said application comprising instructions to (page 4 [0023]):

i. execute a query as specified by said user (page 4 [0023] and [0029] *search engines use the user profiles to search the web; profile information including company affiliations, occupations, etc [0010]* );

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ii. search predetermined Internet sites and exchanges (page 4[0023] and [0045] *the process can select an IP affiliate for marketing the IP asset. In this process, upon registration with the portal, the inventor or IP owner is shown a list or directory of IP affiliates*);

iii. display search results to said user via said terminal, said search results comprising one or more intellectual property listings ([0045] *IP owner is shown a list or directory*); and

iv. enabling said user to indicate a listing of interest (page1 [0006] thru page 2 [0012], [0010] *profile contains areas of interests [0045] to narrow the list the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have*); and

b) assigning a transaction manager (*intellectual property assistant ([0025])* to contact said user and the source of said listing to facilitate a desired transaction related to said listing of interest ([0016] and [0029] *portal delivers focused IP contents to interested subscribers*).

7. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg in view of Boyer et al (US 6,879,990) (hereinafter referred to as Boyer).

Referring to Claim 8:

Lundburg discloses a method wherein the step of searching said plurality of third-party sources includes the steps of:

a) designating a buffer memory for temporary storage of intellectual property listings matching said search criteria (a memory is inherent in the system (Figures 1-2, page 1 [0009] *IP database is searched for records matching the one or more criteria. Client computer displays to the user on the client computer a list of records found in the search (temporary storage of results). User can reject the selected records in the list. Non rejected records are added to user portfolio database (permanent storage); and*

c) searching through the intellectual property listings of said each of said plurality of third-party sources for matches with said respective reformatted search criteria (Figs. 1-2 (22) *search source database.*

d) displaying a list of retrieved hits (Figure 2 (22))

Lundberg does not disclose reformatting the search criteria, searching through the intellectual property listings of a plurality of third party sources with the respective reformatted search criteria, collecting the listing that match the reformatted criteria.

However, Boyer discloses reformatting said search criteria according to requirements of each of said plurality of third-party sources of intellectual property listings, searching through the intellectual property listings of said each of said plurality of third-party sources for matches with said respective reformatted search criteria and collecting such intellectual property listings that match said reformatted criteria and storing said listings in said buffer memory (col. 9, lines 11-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the intellectual property management invention disclosed in

Lundberg with the ability to reformat searches so as to be able access information over the Internet irrespective of the computing platforms of the various databases.

Furthermore, the Examiner takes Official Notice that portals are old and well known. For example, Sequoia, DataChannel, Plumtreeserve as gateways to the Internet by using XML to separate data from the presentation layer, freeing up the portal application to use the same data and information and present it in a variety of formats.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate into Lunberg the ability to format and reformat data so that data can be easily aggregated and organized form across disparate organizations.

Referring to Claim 9:

Boyer discloses a method further comprising the step of:  
reformatting said intellectual property listings stored in said buffer memory in a predetermined format prior to presentation thereof to said at least one of said plurality of users (col. 9, lines 10-34).

Referring to Claim 10:

Lundburg discloses a method further comprising the step of:  
reordering (order again) said intellectual property listings stored in said buffer memory according to predefined criteria prior to presentation thereof to said at least one of said plurality of users (Figs. 1-2 [0009] *the client computer displays to the user on the client computer a list or records found in the search; the set can be groomed (by deletion of unwanted records selected in the query) to form a part or all of the desired user portfolio database of IP assets records. Additional records can be added by specifying them one*

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*at a time or another group can be selected by executing additional searches using different search criteria [0007].*

8. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg as applied to claim 1 above, and further in view of Fischer and Kimball.

Referring to Claim 17:

Lundberg and Fisher disclose a method for searching intellectual property listings and via a portal with the ability to take snapshots. Lundberg nor Fisher explicitly disclose taking a new (updates) snapshot or comparing snapshots or updating snapshots.

However, Kimball discloses periodic snapshots and accumulating snapshots wherein the accumulating snapshot often combines the most recent volatile status with measures that accumulate from the beginning history (page 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the portal exchange and intellectual property trading invention disclosed in Tran and Fisher with the periodic snapshots disclosed in Kimball so as to get a complete picture of a business's database information.

Referring to Claim 18:

Lundburg does not disclose searching reformatted snapshots.

However, Fischer discloses a portal server that captures information snapshots in aggregate XML objects and wherein the portal server includes information connectors

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that allow users to access, retrieve, transform and update information stores in a variety of legacy systems and data sources (page 6 last two paragraphs).

The Examiner takes Official Notice that it is old and well known to search returned search data as is evidenced by an advance Google search or a search using the East database wherein searches are returned, information is displayed and searches can be performed on individual items of interest (see also Snyder US 6,643,641).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the portal exchange and intellectual property invention disclosed in Tran and Fischer the ability to search reformatted snapshots so that the user can refine a search result to find the exact data needed.

***Response to Arguments***

9. Applicant's arguments filed January 23, 2006 have been fully considered but they are not persuasive.

As to the applicant's argument that the Lundberg does not provide the limitation of establishing a connection to sources of intellectual property listings available for transaction, the Examiner disagrees. Available for transacting is a broad concept.

The Microsoft Computer Dictionary defines the term transaction as:

A discrete activity within a computer system such as an entry of a customer order or an update of an inventory item. Transactions are usually associated with database management, order entry, and other online systems.

Lundberg discloses an Internet based method and system for organizing records into user portfolios by retrieving or selecting a set of IP asset records from a source database of IP records [0007]. This is a discrete activity within a computer system.

As for applicant's argument regarding claim 45, the argument is now moot since the Examiner has provided a new grounds of rejection for claim 45.

As for applicant's arguments as to formatting and reformatting data and taking snapshots, the arguments are now moot since the Examiner has provided new grounds for rejection.

Applicant states that Tran does not disclose multiple formats and multiple source, the Examiner respectfully disagrees. Tran is directed to an intellectual property portal that provides a single point of integration, access, and navigation through the multiple enterprise systems and information sources. As disclosed in Fischer, a portal

aggregates and organizes information across disparate organizations within its portal. Most portals use XML as the standard that will enable them to provide access and integration across the disparate applications. XML, unlike HTML, separates the data from the presentation layer, freeing up the portal application to use the same data and information and presents it in a variety of formats. XML does the federated searches since all the data is XML and can be searched. Information portals typically contain XML repositories (memory) that store XML templates. The data is transformed into XML (formatted) and then reformatted. Fischer also discloses information snapshots being captured as XML objects. Therefore, any portal will format and reformat data. Since Tran discloses a portal, Tran formats and reformats data.

The article, *Successful ports marry structured, unstructured data*, teaches that portals can aggregate and organize information from across disparate organizations within its portal.

The Examiner disagrees with the applicant's assertion that Tran does not disclose a query search and directs the applicant to paragraph [0016] and [0017].

As for applicant's argument that Tran does not disclose a fee sharing agreement, the Examiner directs the applicant to paragraph [0017] wherein fees are disclosed and a purchase contract is sent. A purchase contract can have any terms and conditions that the parties agree to insert, including a fee sharing agreement.

As for applicant's arguments that reordering the listings according to predefined criteria prior to presentation means the listing may be displayed in the order received,



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the Examiner disagrees with this assertion. Furthermore, the Examiner has provided a new grounds for rejection as to claim 10.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Larson, Jane discloses the Infoimage Inc.s corporate portal pulls data from ultiple sources and presents it to users and features snapshots (page 3).

Webber (patent no. 5,909,570) discloses template mapping systems for data translation. See figure 14.

IMB Business to Business Integration discloses document exchange with a translator which translates the transmission format.

Enterprise Knowledge discloses corporate portals.

Kujubu, Laura discloses Sequoia XML Portal server with snapshots.

*Experts offer key tips to building, integrating portal marts* discloses that the product needs to output data in a "standard" format.

Harney, John, Portal Knowledge discloses information on enterprise portals.

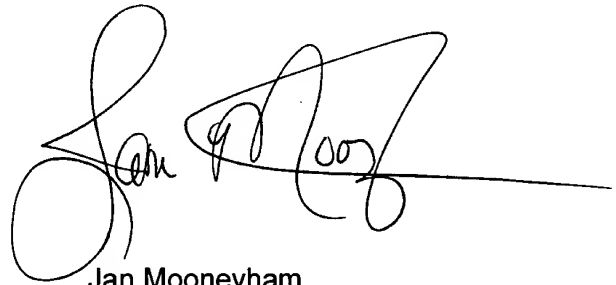
McCright, John, *EMC provides data snapshot* discloses a snapshot of data in a server.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', with a long horizontal line extending to the right.

Jan Mooneyham  
Patent Examiner  
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